
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.: 10/642,928

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Inventors:

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Examiner: Shaw, Peling Andy

Group/Art Unit: 2144

Atty. Dkt. No: 5681-66300

Title: STRUCTURED
METHODOLOGY AND
DESIGN PATTERNS FOR
WEB SERVICES

REQUEST FOR RECONSIDERATION OF PETITION UNDER 37 CFR 1.144

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This paper is submitted as request for reconsideration of Applicant's previous petition under 37 CFR 1.144 from the restriction requirement stated in the Office Action dated June 29, 2007. In the Decision mailed May 27, 2009, Applicant's previous petition was denied. Applicant provides further support below as to why the restriction requirement is improper.

The Examiner required restriction to one of the following inventions as defined by the Examiner:

- I. Claims 1-17, drawn to electrical computers and digital processing systems: multi-computer data transferring, particularly distributed data processing in client/server, in class 709, subclass 203.
- II. Claims 18-19, 20-37, and 38-55 drawn to electrical computers and digital processing systems: multi-computer data transferring,

particularly remote data accessing using interconnected networks, classified in class 709, subclass 218.

- III. Claims 56-69, drawn to electrical computers and digital processing systems: multi-computer data transferring, particularly network computer configuring, classified in class 709, subclass 220.
- IV. Claims 70-80, drawn to electrical computers and digital processing systems: multi-computer data transferring, particularly network resources access controlling in computer-to-computer session/connection establishing, classified in class 709, subclass 229.

Applicant traverses the restriction requirement on the grounds that the Examiner (and the Decision of May 27, 2009) has failed to state a proper requirement for restriction under 35 U.S.C. § 121, as explained below.¹

As a preliminary matter, Applicant objects to the Decision of May 27, 2009 providing an “expanded rationale” for the restriction requirement. According to the MPEP, the Examiner has the burden to establish a proper restriction requirement. If the Examiner’s rationale was in any way lacking, then Applicant’s petition should have been granted and it should have been up to the Examiner to assert a new restriction with proper rationale. Nevertheless, as demonstrated below, the expanded rationale provided in the Decision also fails to establish a proper restriction requirement.

1. The claim groups recite different statutory categories and thus cannot all be restricted as subcombinations usable together in the *same* combination

Note that MPEP § 806.05 draws a distinction between restricting inventions in the same statutory category as opposed to inventions in different statutory categories. The restriction for all of Inventions I-IV is based on MPEP § 806.05(d) as subcombinations

¹ Applicant makes no admission in regard to the patentable distinctiveness of any of the claims relative to any other claim. Instead, Applicant’s traversal is on the grounds that the Office has not met its burden in regard to numerous elements that must be established by the Office before restriction can be required.

usable together in the same combination. This type of restriction only applies to inventions in the same statutory category. However, several of the enumerated claim groups are specific to different statutory categories and thus cannot be properly restricted under MPEP § 806.05(d). For example, Invention I is directed to a system, whereas Inventions III and IV are directed to methods. Note that the requirements for restriction between a system (apparatus) and a method (process) are different than the requirements for restriction when the claims all pertain to the same statutory category. See MPEP §§ 806.05(e), (f), (h), (i) and (j) for the requirements for restricting claims to different statutory categories. Since the claim groups were all improperly analyzed under MPEP § 806.05(d), a proper restriction requirement has not been established.

2. The claim groups do not require mutually exclusive (non-overlapping) subcombinations

The Office bases the restriction requirement on MPEP 806.05(d). However, MPEP 806.05(d) does not apply to Inventions I, II, III and IV as defined in the Office Action. To be restrictable, MPEP 806.05(d) requires that the different claim groups must be directed to different subcombinations that are usable together in the same combination where “the subcombinations do not overlap in scope.” However, Inventions I, II, III and IV are not claimed as separate subcombinations that do not overlap in scope and are usable in the same combination. As stated in MPEP 806.05(a), a subcombination is a particular part or element of a larger combination. Thus, for proper restriction under MPEP 806.05(d), the different claim groups must be limited to separate and non-overlapping parts of a larger combination. However, Inventions I, II, III and IV are not limited to separate and non-overlapping subcombination parts of a larger combination.

For example, claim 1 (Invention I) and claim 20 (Invention II) both recite a vendor-independent Web Service architecture comprising a plurality of heterogeneous components in accordance with one or more design patterns. Claim 56 (Invention III) and claim 70 (Invention IV) also recite a vendor-independent Web Service architecture and applying one or more design patterns to the Web Service architecture. Inventions I,

II, III and IV all overlap in scope in regard to a vendor-independent Web Service architecture. Thus, instead of reciting non-overlapping subcombinations as required for restriction under MPEP 806.05(d), Inventions I, II, III and IV have an explicit overlap in scope. Thus, Inventions I, II, III and IV do not meet the requirement of MPEP 806.05(d) that the subcombinations must not overlap in scope. Note that MPEP 806.05 requires that to be restrictable, different subcombinations must be “mutually exclusive” (i.e., non-overlapping in scope) such that “a first invention would not infringe a second invention, and the second invention would not infringe the first invention.” Thus, according to MPEP 806.05, if two different claim groups read on the same invention embodiment, then they cannot be restricted as separate subcombinations. Applicants’ specification clearly discloses an embodiment of the inventive method that could infringe each of claim 20 (Invention II), claim 56 (Invention III) and claim 70 (Invention IV). Thus, per the explicit requirement of MPEP 806.05 and MPEP 806.05(d), these claims cannot be restricted as subcombinations. The overlap in scope is clear.² According to MPEP 806.05(d), different claim groups cannot be restricted under MPEP 806.05(d) if they overlap in scope. Accordingly, a valid restriction requirement has not been stated.

The Decision of May 27, 2009, on p. 6 asserts that Group I contains one or more mutually exclusive characteristics from Group II, III and IV such as service requestors and service provider. **This statement is demonstrably false.** The claims of Groups II, III and IV do not exclude service requestors and service provider. In fact, service requestors and a service provider are explicitly recited in each of the other Groups. *See, e.g.*, claim 23 (Group II), claim 60 (Group III), and claim 73 (Group IV). The Decision also states that Group II contains the mutually exclusive characteristic of generating a high-level architecture for web services. Again, this assertion is simply not true. None of the other Groups exclude generating a high-level architecture for web services. As recited in claim 18 and in the specification, generating the high-level architecture is part of generating a vendor-independent Web Service architecture. Since the vendor-independent Web Service architecture is included in all of the claim Groups, the high-

² Applicant is not arguing that the scope of the claims of Invention I and Invention II are identical, only that their respective scopes overlap.

level architecture is clearly not excluded by any of the claims. The Decision also incorrectly refers to translating the one or more use case requirements and one or more technical constraints as a mutually exclusive characteristic of Group III. According to claim 56, this translating is performed in order to determine the plurality of heterogeneous Web Service components. However, claims 1, 18, 20 and 38 all refer to heterogeneous Web Service components which, according to the specification, may be determined by translating one or more use case requirements and one or more technical constraints. None of the claim Groups exclude translating one or more use case requirements and one or more technical constraints. The Decision also incorrectly refers to identifying one or more trust domains as a mutually exclusive characteristic of Group IV. However, none of the other claim groups exclude identifying one or more trust domains as part of generating the vendor-independent Web Service architecture that is recited in all claim Groups.

The Examiner and the Decision have failed to appreciate the proper definition of “mutually exclusive.” To be mutually exclusive, on claim must recite a feature that cannot exist within the scope of the other claim. Or, as stated in MPEP 806.05, “a first invention would not infringe a second invention, and the second invention would not infringe the first invention.” None of the examples provided in the Decision meet this definition. For example, an infringer could easily practice one method that would infringe all of claims 20, 56 and 70. Just because these claims do not recite identical features does not mean that each claim excludes any of the features of the other. In fact, it is clear from the specification that a single method of implementing a Web Services architecture may include the features of all of these claims. Thus, the features listed in on p. 6 of the Decision are explicitly not mutually exclusive features. To the contrary, they are all examples of where the claims may overlap in scope.

3. The Office has not shown that either of the subcombinations has utility “other than in the disclosed combination”

According to MPEP 806.05(d), to state a proper restriction requirement for subcombinations usable together in a single combination, “[t]he examiner must show, by way of example, that one of the subcombinations has utility other than in the disclosed combination.” (emphasis added). MPEP 806.05(d) also states that “the burden is on the examiner” to make this showing. Page 5 of the Decision essentially states that certain particulars of each claim Group are not required by the others and thus each Groups has a separate utility. Given the overlap in scope as discussed above, there is no basis for the assertion that the differences in wording of the claims somehow establishes separate utilities. Also, the Decision makes vague generalizations instead of providing actual examples as required by MPEP 806.05(d). Most importantly, the Decision has misapplied the utility requirement as stated in MPEP 806.05(d). The requirement is not that a subcombination have a separate utility with respect to another subcombination, but that a subcombination has a “utility other than in the disclosed combination.” **Note that simply pointing out differences in claim limitations can never satisfy the utility requirement of MPEP 806.05(d) because for subcombinations useable together in a single combination all claim limitations must, by definition, have utility in the disclosed combination.** By definition, each true subcombination must be a distinct, non-overlapping component of a disclosed combination. Thus, all claim limitations of all subcombinations must always have utility in the disclosed combination. The utility requirement of MPEP 806.05(d) is to show that one of the subcombinations has utility **“other than in the disclosed combination.”** Because all the claim limitations must have utility in the combination of which the subcombination is a part, this requirement can not be satisfied by merely referring to a particular claim limitation that is present in one claim but not in another.

All the utility examples provided by the Examiner and in the Decision are examples of utilities in the combination as disclosed in the specification that would

include any of Inventions I-IV.³ Thus, the Office has specifically not shown that any of the subcombinations has utility **other than in the disclosed combination**, as required by MPEP 806.05(d). Accordingly, a proper restriction requirement has not been stated. No actual examples have been provided at all, let alone examples of utilities “other than in the disclosed combination.” Note that all the particulars recited in all of the claim Groups must have utility in the disclosed combination, by definition. Thus, the reference in the Decision to the different particulars of each claim Group cannot satisfy the utility requirement of MPEP 806.05(d) which requires utilities not in the disclosed combination.

4. The Office does not show “reasons why there would be a serious burden on the examiner if restriction is not required”

MPEP § 808 requires that for all restriction requirements, the Office must show “reasons why there would be a serious burden on the examiner if restriction is not required.” A “mere statement of conclusion is inadequate.” MPEP 808.01. In an apparent attempt to satisfy this requirement, the Decision states that one or more of five different reasons apply. However, the Office does not explain how or why any of the reasons actually apply to the present application. Merely stating that one or more reasons apply does not make it so. **According to M.P.E.P. § 808.02, the Office “must show by appropriate explanation” that a valid reason applies.** However, the Office made no attempt to explain how or why any of the reasons apply. Also, only the first three reasons listed are recognized as valid reasons for restriction in M.P.E.P. § 808.02. Accordingly, the requirement of M.P.E.P. § 808.02 has not been met. Thus, the restriction requirement must be withdrawn.

Applicant’s previous petition asserted that the separate classifications provided for the different claim groups did not establish a serious burden because, as proven in the previous petition, the provided classifications are inaccurate and/or would each apply to all the claims. Such flawed and inaccurate classifications that apply to all claim groups

³ Applicant is not asserting that no such utility is possible, but instead is noting that the Office has not met its burden in regard to this requirement to establish a need for restriction.

clearly do not establish “a serious burden on the examiner if restriction is not required.” The Decision did not dispute this showing. Instead, the Decision on p. 7 made the completely conclusory and unsupported assertion that the subcombinations have distinct subject matter which requires a separate field of search. The Decision did not explain why this would necessarily be the case. In fact, it is entirely possible to have distinct claims that have the same field of search. The Decision did not even explain what the separate fields of search would be. According to M.P.E.P. § 808.02, the Office “must show by appropriate explanation” that reasons exist as to “why there would be a serious burden on the examiner if restriction is not required.” **A “mere statement of conclusion is inadequate.”** MPEP 808.01.

The Decision is simply relying on the assertion that the Groups have distinct subject matter. However, as shown above, the requirements to establish the distinctiveness of the claim Groups have not been met. Moreover, the Decision is improperly conflating the distinctiveness requirement with the serious burden requirement. According to MPEP § 808, these are two separate requirements. The Office cannot use the assertion that the Inventions are distinct to automatically justify separate fields of search and a serious burden. **If such an analysis was proper then the separate requirement to establish a serious burden would be rendered meaningless.** Therefore, since no proper justification as to why “there would be a serious burden on the examiner if restriction is not required” has been provided, a proper restriction requirement has not been established.

CONCLUSION

In light of the above remarks, Applicant requests that the restriction requirement be withdrawn and all claims be examined.

If any extension of time (under 37 C.F.R. § 1.136) is necessary to prevent the above referenced application from becoming abandoned, Applicant hereby petitions for such extension. If any fees are due, the Commissioner is authorized to charge said fees to Meyertons, Hood, Kivlin, Kowert & Goetzel PC Deposit Account No. 501505/5681-66300/RCK.

Respectfully submitted,

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